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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,760	05/23/2001	Gregg Henderson	98A16-US HEN	2331

25547 7590 10/31/2003

PATENT DEPARTMENT
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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 10/31/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,760

Applicant(s)

HENDERSON ET AL.

Examiner

Alton N. Pryor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 9-20 is/are allowed.
- 6) ☐ Claim(s) 1,2,4,5,21-24,27 and 28 is/are rejected.
- 7) ☐ Claim(s) 3,6-8,25 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

- I. Rejection of claims 1-5 under 35 USC 102(b) will not be maintained in light of amendment filed 8/4/03. The prior art does not teach or suggest termite control.
- II. Rejection of claims 1-4,7,8 under 35 USC 102(b) as being anticipated by JP '129 will not be maintained in light of amendment filed 8/4/03. The prior art does not teach or suggest termite control.
- III. Rejection of claims 1-4,6,8 under 35 USC 102(b) as being anticipated by Nishimura will not be maintained in light of amendment filed 8/4/03. The prior art does not teach or suggest termite control.
- IV. Rejection of claims 1-5,8 under 35 USC 102(b) as being anticipated by Kashiwara will not be maintained in light of amendment filed 8/4/-3. The prior art does not teach or suggest termite control.

Response to Amendment

Applicant's arguments filed 8/4/03 have been fully considered but they are not persuasive.

- V. Rejection of claims 21,22,27 under 35 USC 102(b) as being anticipated by Baxter will be maintained for reasons on record and reasons as follows. Applicant includes the statement "wherein said wood building material without said compound is susceptible to termite infestation." Examiner argues that in a claim to a composition, the intended use or intended function of a component of the composition offers no patentable significance.

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VI. Rejection of claim 28 under 35 USC 102(b) as being anticipated by JP '129 will be maintained for reasons on record and reasons as follows. Applicant includes the statement "wherein said wood building material without said compound is susceptible to termite infestation." Examiner argues that in a claim to a composition, the intended use or intended function of a component of the composition offers no patentable significance.

VII. Rejection of claim 28 under 35 USC 102(b) as being anticipated by Nishimura will be maintained for reasons on record and reasons as follows. Applicant includes the statement "wherein said wood building material without said compound is susceptible to termite infestation." Examiner argues that in a claim to a composition, the intended use or intended function of a component of the composition offers no patentable significance.

VIII. Rejection of claims 21,22,27 under 35 USC 102(b) as being anticipated by Kashihara will be maintained for reasons on record and reasons as follows. Applicant includes the statement "wherein said wood building material without said compound is susceptible to termite infestation." Examiner argues that in a claim to a composition, the intended use or intended function of a component of the composition offers no patentable significance.

IX. Rejection of claims 22-24 under 35 USC 103(a) as being obvious over Baxter as applied to claims 21,22,27 will be maintained for reasons on record.

X. Rejection of claims 22,24 under 35 USC 103(a) as being obvious over Kashihara as applied to claims 22-24 will be maintained for reasons on record.

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XI. Objection to claims 25,26 will be maintained for reasons on record. Claims 3,6-8 are added to this objection.

XII. New 35 USC 103(a) rejection:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,4,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi (WO 99/25196; 5/27/99). Takagi teaches that nootkatone is used to repel indoor hematophagous insects. Takagi does not teach that nootkatone repels termites. However, one having ordinary skill in the art would have been expected to use nootkatone to repel termites. One would have been motivated to do this since termites are insects.

Allowable Subject Matter

Claims 9-20 are allowable. The prior art does not teach or suggest a composition comprising nootkatone, zizanol, or bicyclovetivenol plus a substrate selected from mulch, soil, or diatomaceous earth.


Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 703 308-4691. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.


ALTON N. PRYOR
PRIMARY EXAMINER
Alton Pryor
Primary Examiner
AU 1616